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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,994	12/22/2000	Paul Levi Williams JR.	088305/0121	7764

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EXAMINER

CUFF, MICHAEL A

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 03/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/741,994

Applicant(s)

WILLIAMS ET AL.

Examiner

Michael Cuff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-2, 10, 13, 14-16, 19-20, 24, and 27-28 are rejected under 35

U.S.C. 102(a) as being anticipated by www.ediconsulting.com.

www.ediconsulting.com (host server), dated 14 October 1999 and copyrighted 1996, is accessible to individual user via the internet. From the home page, click on “consulting services” (section A). This page shows mapping support. Mapping is the development of a transaction set customized to match the format that two trading partners have agreed to use for exchanging one type of transaction. (This includes obtaining user registration and requirement information, retrieving requirements, and “automatically” determining a suitable EDI product in that some form of automation is used during the process.) The page shows a testing section, which says, “It’s likely we have already done EDI with your trading partners. Let our broad industry experience speed up your EDI implementation.” The reference is silent to having a database for information on a plurality of hub trading partners, but the previous statement strongly implies that a database of information on trading partners is inherent. Computer flow diagrams are forms of decision tree formats. Prompts are inherent in an interactive computer system. Mapping services are EDI services, which www.ediconsulting.com

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(host server) automatically determined suitable to sell, particularly to help interface with the requirements of other trading partners.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-9, 11-12, 17-18, 21-23, and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over www.ediconsulting.com in view of Call, Reed et al., and Bakalash et al.

www.ediconsulting.com, as described above, shows all of the limitations of the claims except for specifying preformatted displays with divided registration information, the ability to supplement the information, the use of a "cookie" and generating ROI information.

Call teaches, figure 2, a method and apparatus for disseminating product information via the Internet. The information is transferred via EDI methods and uses preformatted displays in order to provide greater ease for customer interaction.

Based on the teaching of Call, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the www.ediconsulting.com system such that it used preformatted displays in order to provide greater ease for customer interaction.

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Reed et al. teaches when the user connects to the web server with the browser, the web server can interrogate the browser for the cookie and use it to identify the user. The cookie can additionally store preference data about the user, whether entered manually by the user via HTML forms or collected automatically by the web server based on the user's browsing choices. Cookies are an attempt to surmount the manual data entry and maintenance requirements of the first approach above.

Based on the teaching of Reed et al., it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the www.ediconsulting.com system to incorporate "cookies" in order to facilitate the identification of the user.

Bakalash et al. teaches mapping processes on integer-encoded business dimensions. The system uses EDI and provides ROI data for services in order to provide selling point to a customer.

Based on the teaching of Reed et al., it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the www.ediconsulting.com system to incorporate the ROI data of Bakalash et al. in order to provide selling point to a customer.

Response to Arguments

Applicant's arguments filed 12/22/04 have been fully considered but they are not persuasive.

Applicant asserts that the prior art does not show automatic determination of suitable EDI products or services. The examiner does not concur. The prior art has automatically determined that mapping services are suitable for a user, particularly to help interface with the requirements of other trading partners.

Applicant asserts that the reference does not meet the criteria for inherency.

First, the claimed limitation in question:

"a database for storing requirements information relating to predetermined electronic commerce EDI requirements of a plurality of trading partners;"

This is a very vague database. It has intended use for storing some kind of information about requirements of trading partner.

Mapping is the development of a transaction set customized to match the format that two trading partners have agreed to use for exchanging one type of transaction. It would be fair to say that there was some kind of information about requirements of trading partners necessary to perform this function. The page shows a testing section, which says, "It's likely we have already done EDI with your trading partners. Let our broad industry experience speed up your EDI implementation." It would be fair to say that the reference saved some of its past work facilitate future jobs, thus meeting the broadly recited database.

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Applicant has recited a section from MPEP 2112. The next paragraph after applicant's citation reads:

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)

Based on the extremely broad limitation and the examiners technical reasoning to reasonably support the determination, the examiner believes that the criterion for inherency has been show.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Cuff whose telephone number is (703) 308-0610 or, after 4/13/05, (571)272-6778. The examiner can normally be reached on 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Cuff 3/1/05

Michael Cuff
March 1, 2005